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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,279	07/18/2001	Kazumi Iijima	114474-13-FES100001	5027

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EXAMINER
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AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/647,279

Applicant(s)

IJIMA, KAZUMI

Examiner

Walter B. Aughenbaugh

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: none.  
Claim(s) objected to: none.  
Claim(s) rejected: 1, 3, 5 and 7-9.  
Claim(s) withdrawn from consideration: 6.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

## **ADVISORY ACTION**

### ***Acknowledgement of Applicant's Amendments***

1. The After Final Amendment filed April 11, 2005 has not been entered due to the fact that the amendments raise new issues that would require further consideration and/or search. The addition of the recitations "the outer cylinder is made of cyclic polyolefin resin" and "a sandblasted surface" raise new issues that would require further consideration and/or search.
2. Note that 37 CFR 1.121 requires that the text of withdrawn claim 6 be included in the listing of claims.

### ***Response to Arguments***

3. Applicant's arguments in regard to the 35 U.S.C. 102 rejection of claim 1 presented on pages 3-4 of the After Final Amdt. are moot since the After Final Amdt. has not been entered for the reason provided above. Applicant's arguments in the three full paragraphs of page 4 of the After Final Amdt. depend upon the "sandblasted surface" recitation, which has not been entered for the reason provided above.
4. Applicant argues that there is no motivation to combine Moncada et al. with Porfano et al. in the paragraph bridging pages 4 and 5 of the After Final Amdt. This argument applies to the 35 U.S.C. 103 rejection of claim 9, since the After Final Amdt. has not been entered for the reason provided above. One of ordinary skill in the art would have recognized to consult Porfano et al. to determine the particular material to use for the syringe barrel because Porfano et al. teach that cyclic polyolefin copolymers are suitable plastics to use as a syringe barrel material since cyclic polyolefin copolymers typically do not require a clarifying agent (col. 6, lines 46-48), as made of record in paragraph 8 of the previous Office Action mailed January 11, 2005. Porfano et

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al. plainly teaches that cyclic polyolefin copolymer is a suitable material for use as a syringe barrel; therefore, one of ordinary skill in the art would have recognized to have used the cyclic polyolefin copolymer of Porfano et al. as the material of the syringe barrel of Moncada et al.

5. On page 5 of the After Final Amdt., Applicant argues that the recitation "formed by blast treatment" of claims 1, 5 and 7 should be given patentable weight because MPEP 2173.05(g) "explicitly states that a functional limitation must be evaluated and considered", but the recitation "formed by blast treatment" is not a functional limitation. A functional limitation is a limitation reciting what the claimed article does, not how it is formed.

6. Applicant's arguments in regard to claim 10 presented on pages 5-6 of the After Final Amdt. are moot since the After Final Amdt., and therefore claim 10, has not been entered for the reason provided above.

### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

04/20/05

WBA

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

4/20/05